

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Scott H. Freeman et al.)
)
Assignee: Primal Elements, Inc.) Group Art Unit 1442
)
Appl. No.: 09/883,168) Examiner: James C. Yeung
)
Filed: June 14, 2001)
)
For: DECORATIVE CANDLE)
DISPLAY)
)

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PETITION UNDER 37 C.F.R. § 1.48(a) FOR
CORRECTION OF INVENTORSHIP OF U.S. PATENT APPLICATION
NO. 09/883,168 PURSUANT TO 35 U.S.C. § 116

Assistant Commissioner for Patents
ATTENTION: OFFICE OF PETITIONS
Crystal Park 1, Room 520
Washington, D.C. 20231

Dear Sir:

Pursuant to 35 U.S.C. § 116, 37 C.F.R. § 1.48(a), and M.P.E.P. § 201.03, Primal Elements, Inc., ("Primal Elements") hereby petitions the Commissioner to correct the inventorship of United States Patent Application No. 09/883,168 ("the '168 application") to name Faith Freeman, Scott H. Freeman and Frank H. Asbury as inventors in the application.

I. THROUGH ERROR WITHOUT ANY DECEPTIVE INTENT, ONE INVENTOR WAS
OMITTED AS INVENTOR OF CLAIMS

United States Patent Application No. 09/883,168 is a reissue application of United States Patent Application No. 09/559,689 which has issued as United States Patent No. 6,171,102 (the '102 patent).

The '168 application contained the 22 claims from the '102 patent. By way of Preliminary

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Amendment filed on June 14, 2001, new Claims 23 to 31 were added.

In filing and prosecuting the '168 patent application, as in the '102 patent, I was informed and believed in good faith and without any deceptive intent that Scott H. Freeman and Frank H. Asbury were the inventors of the subject matter of each of the twenty-two (22) claims in the original application, all of which issued without amendment in the '102 patent, as well as the inventors of the new Claims 23 to 31 which were added by Amendment on June 14, 2001. Accordingly, the Declaration filed with the application listed Scott H. Freeman and Frank H. Asbury as the inventors in the application. The patent application was filed and prosecuted at all times in good faith and without any deceptive intent.

I have recently learned that an additional inventor, Faith Freeman, is a joint inventor with Scott H. Freeman and Frank H. Asbury of the subject matter of Claims 1-31 of the '168 application. This error in identifying the proper inventorship of Claims 1-31 arose without any deceptive intent on my part, or on the part of any of the three inventors. *See* Decl. of Faith Freeman ¶5; Decl. of Scott H. Freeman ¶6; Decl. of Frank H. Asbury ¶6.

Pursuant to 37 C.F.R. § 1.48(a), each of the three inventors agree to this request to change the inventorship of the '168 application to name Faith Freeman, Scott H. Freeman, and Frank H. Asbury as co-inventors on the patent. *See* Decl. of Faith Freeman ¶6; Decl. of Scott H. Freeman ¶7; Decl. of Frank H. Asbury ¶7.

II. ESTABLISHMENT OF ASSIGNEE PRIMAL ELEMENTS' RIGHT TO TAKE ACTION PURSUANT TO 37 C.F.R. § 3.73(b)

Primal Elements is the owner of all right, title, and interest in the '168 application. *See* Stmt. of Assignee Primal Elements, Inc. ¶6. Each of the inventors of the '102 patent and '168 application, namely Faith Freeman, Scott H. Freeman, and Frank H. Asbury, has executed "Assignment and Confirmation of Assignment", a copy of which is filed with the Petition. *Id.* ¶4. Simultaneous with the filing of this Petition, and pursuant to 37 C.F.R. § 3.11, Primal Elements is recording the original "Assignment and Confirmation of Assignment" with the Assignment Branch of the United States Patent and Trademark Office. *Id.* ¶5. A copy of the "Recordation Form Cover Sheet" is also filed with this Petition.

Pursuant to 37 C.F.R. § 1.48(a), Primal Elements agrees to the requested change of the

inventorship of the '168 application to identify the named inventors as Faith Freeman, Scott H. Freeman, and Frank H. Asbury. *Id.* ¶7. Primal Elements thus requests that the Commissioner take action in this matter to correct the inventorship of the '168 application. *Id.* ¶8.

**III. SUBMISSION OF A DECLARATION OF EACH ACTUAL INVENTOR AS
REQUIRED BY 37 C.F.R. § 1.63**

Pursuant to 37 C.F.R. § 1.48(a), Primal Elements files with this Petition a Declaration by each actual inventor as required by 37 C.F.R. § 1.63, signed by each of the actual inventors, namely Faith Freeman, Scott H. Freeman, and Frank H. Asbury.

IV. PAYMENT OF REQUIRED FEE AS SET FORTH IN C.F.R. § 1.17 (i)

Finally, pursuant to 37 C.F.R. §§ 1.48(a) and 1.17(i), Primal Elements files with this Petition a check for \$130.00, made payable to the Commissioner of Patents, for the required processing fee for correcting inventorship in an application. Please charge any additional necessary fees for this Petition to Deposit Account No. 19-4330.


V. CONCLUSION

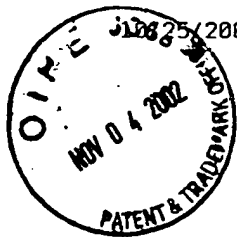
For the foregoing reasons, Primal Elements respectfully requests the Commissioner to correct the inventorship of the '168 application to name Faith Freeman, Scott H. Freeman, and Frank H. Asbury as inventors in the patent. If you have any questions in this regard, please do not hesitate to contact the undersigned attorney.

Date: 10/29/02

Customer No. 007663

Respectfully submitted:

By: 
Kit M. Stetina
Registration No. 29,445
Stetina Brunda Garred & Brucker
75 Enterprise, Suite 250
Aliso Viejo, CA 92656
(949)855-1246



DECLARATION OF FAITH FREEMAN

I, Faith Freeman, declare as follows:

1. Unless otherwise stated, all statements in this Declaration are made on the basis of my own personal knowledge.
2. My residence address is 19582 Cloverwood Circle, Huntington Beach, California, 92648.
3. I am the CEO of Primal Elements, Inc., whose business address is 12472 Edison Way, Garden Grove, CA 92841.
4. I am one of the inventors of the subject matter of Claims 1-31 of United States Patent Reissue Application No. 09/883,168 ("the '168 application").
5. Scott H. Freeman and Frank H. Asbury are joint inventors with me of the subject matter of Claims 1-31 of the '168 application. Through error, I was not named in the '168 application as an inventor, and such error arose without any deceptive intent on my part.
6. I agree to the requested change of the inventorship of the '168 application to identify the named inventors as Faith Freeman, Scott H. Freeman, and Frank H. Asbury.
7. I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under section 1001 of Title 18 of the United States Code, and that such willful false statements made jeopardize the validity of the application or any patent issuing thereon.

Executed this 25 day of October, 2002


Faith Freeman

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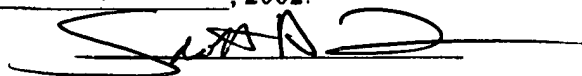
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DECLARATION OF SCOTT H. FREEMAN

I, Scott H. Freeman, declare as follows:

1. Unless otherwise stated, all statements in this Declaration are made on the basis of my own personal knowledge.
2. I am one of the named inventors in United States Reissue Patent Application No. 09/883,168 ("the '168 application").
3. My residence address is 19582 Cloverwood Circle, Huntington Beach, California, 92648.
4. I am the President of Primal Elements, Inc., whose business address is 12472 Edison Way, Garden Grove, CA 92841.
5. I am one of the named inventors of the subject matter of Claims 1-31 of the '168 application.
6. Faith Freeman and Frank H. Asbury are joint inventors with me of the subject matter of Claims 1-31 of the '168 application. Through error, Faith Freeman was not named in the '168 application as an inventor, and such error arose without any deceptive intent on my part.
7. I agree to the requested change of the inventorship of the '168 application to identify the named inventors as Faith Freeman, Scott H. Freeman, and Frank H. Asbury.
8. I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under section 1001 of Title 18 of the United States Code, and that such willful false statements made jeopardize the validity of the application or any patent issuing thereon.

Executed this 25 day of Oct, 2002.



Scott H. Freeman

DECLARATION OF FRANK H. ASBURY

I, Frank H. Asbury, declare as follows:

1. Unless otherwise stated, all statements in this Declaration are made on the basis of my own personal knowledge.
2. I am one of the named inventors in United States Reissue Patent Application No. 09/883,168 ("the '168 application").
3. My residence address is 144 North Trevor Street, Anaheim, California, 92806.
4. I am the Director of Research and Development of Primal Elements, Inc., whose business address is 12472 Edison Way, Garden Grove, CA 92841.
5. I am one of the named inventors of the subject matter of Claims 1-31 of the '168 application.
6. Faith Freeman and Scott H. Freeman are joint inventors with me of the subject matter of Claims 1-31 of the '168 application. Through error, Faith Freeman was not named in the '168 application as an inventor, and such error arose without any deceptive intent on my part.
7. I agree to the requested change of the inventorship of the '168 application to identify the named inventors as Faith Freeman, Scott H. Freeman, and Frank H. Asbury.
8. I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under section 1001 of Title 18 of the United States Code, and that such willful false statements made jeopardize the validity of the application or any patent issuing thereon.

Executed this 25 day of OCTOBER, 2002.


Frank H. Asbury

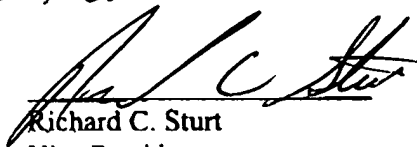
STATEMENT OF ASSIGNEE PRIMAL ELEMENTS, INC.

I, **RICHARD C. STURT**, state as follows:

1. All statements in this Statement are made on the basis of my own personal knowledge.
2. I am the Vice President of Primal Elements, Inc. ("Primal Elements"), whose business address is 12472 Edison Way, Garden Grove, California, 92841.
3. As Vice President of Primal Elements, I am authorized to act on behalf of Primal Elements.
4. Filed herewith is a true and correct copy of a fully executed and notarized "Assignment and Confirmation of Assignment", signed by each of the inventors of the United States Reissue Patent Application No. 09/883,168 ("the '168 application"), namely Faith Freeman, Scott H. Freeman, and Frank H. Asbury.
5. Simultaneous with its filing of this "Petition Under 37 C.F.R. § 1.48(a) for Correction of Inventorship of U.S. Patent Application No. 09/883,168 Pursuant to 35 U.S.C. § 116", Primal Elements is submitting the original "Assignment and Confirmation of Assignment" for recordation with the Assignment Branch of the United States Patent and Trademark Office.
6. This Assignment (including the "Employee Confidentiality, Assignment, and Proprietary Rights Agreement" referenced therein) represents the entire chain of title of this invention from the inventors to Primal Elements, the assignee. I have reviewed this Assignment, and to the best of Primal Elements' knowledge and belief, Primal Elements is the owner of the entire right, title and interest in the above-referenced '168 application.
7. Primal Elements agrees to the requested change of the inventorship of the '168 application to identify the named inventors as Faith Freeman, Scott H. Freeman, and Frank H. Asbury.
8. Primal Elements requests that the Commissioner take action in this matter to correct the inventorship of the '168 application.
9. I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further

that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under section 1001 of Title 18 of the United States Code, and that such willful false statements made jeopardize the validity of the application or any patent issuing thereon.

Executed this 25th day of October, 2002.



Richard C. Sturt
Vice President
Primal Elements, Inc.

ASSIGNMENT AND CONFIRMATION OF ASSIGNMENT

WHEREAS we, FAITH FREEMAN, a United States citizen, residing at 19582 Cloverwood Circle, Huntington Beach, California, 92648, SCOTT H. FREEMAN, a United States citizen, residing at 19582 Cloverwood Circle, Huntington Beach, California, 92648 and FRANK H. ASBURY, a United States citizen, residing at 144 North Trevor Street, Anaheim, California, 92806, have invented certain new and useful improvements in a "DECORATIVE CANDLE DISPLAY" for which we filed a reissue application of Application No. 09/559,689 filed on April 27, 2000 which matured into United States Letters Patent 6,171,102 on January 9, 2001 for Letters Patent in the United States on June 14, 2001 as Application No. 09/883,168 ("the '168 application");

AND WHEREAS we FAITH FREEMAN, SCOTT H. FREEMAN and FRANK H. ASBURY have each individually executed an "Employee Confidentiality, Assignment, and Proprietary Rights Agreement", which assigned to Primal Elements, Inc., all of our "interest in any idea and/or invention, whether patentable or not, made or conceived by [us], solely or jointly with others, during the term of [our] employment...";

AND WHEREAS PRIMAL ELEMENTS, INC. (hereinafter "ASSIGNEE"), a California Corporation, with its principal place of business at 12472 Edison Way, Garden Grove, California, 92841, desires to specifically confirm that it has acquired the entire right, title and interest in and to said improvements, including the '168 application, and to the extent that it has not, to acquire the entire right, title and interest in and to said improvements, including the '168 application.

NOW, THEREFORE, in further consideration of the sum of One Dollar (\$1.00), and other good and valuable consideration, the receipt of which is hereby acknowledged, we, the said inventors, do hereby confirm and acknowledge that we have sold, assigned, transferred, and conveyed, and by these presents do hereby sell, assign, transfer and convey, unto the ASSIGNEE, its successors, legal representatives, and assigns, the entire right, title and interest throughout the world in, to and under said improvements, and the application and all provisional applications relating thereto, and all divisions, renewals and continuations thereof, and all Letters Patents of the United States which may be granted thereon and all reissues and extensions thereof (including the '168 application), and all rights of priority under International Conventions and applications for Letters Patent which may hereafter be filed for said improvements in any country or countries foreign to the United States, and all Letters Patent which may be granted for said improvements in any country or countries foreign to the United States, and all extensions, renewals, and reissues thereof, and we hereby authorize and request the Commissioner of Patents of the United States, and any Official of any country or countries foreign to the United States, whose duty it is to issue patents on applications as aforesaid, to issue all Letters Patent for said improvements to ASSIGNEE, its successors, legal representatives and assigns, in accordance with the terms of this instrument.

AND WE HEREBY sell, assign, transfer, and convey to the ASSIGNEE, its successors, legal representatives and assigns, all prior claims for damages and other remedies in respect of any infringement of the '168 application which may have accrued or may accrue, including the right to sue for and collect and retain damages for past infringement of the '168 application.

AND WE HEREBY covenant and agree that we will communicate to the ASSIGNEE, its successors, legal representatives, and assigns any facts known to us respecting said improvements, and testify in any legal proceeding, sign all lawful papers, execute all divisional, continuing, and reissue applications, make all rightful oaths and generally do everything possible to aid the ASSIGNEE, its successors, legal representatives, and assigns to obtain and enforce proper patent protection for said improvements in all countries.

IN TESTIMONY WHEREOF, I hereunto set my hand and seal this 25 day of OCT, 2002.


Faith Freeman

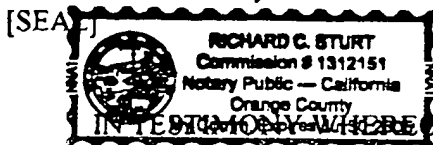
STATE OF CALIFORNIA

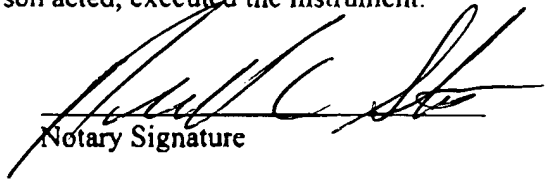
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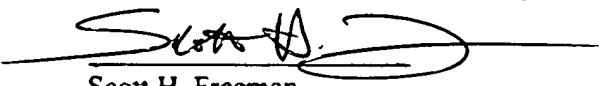
On OCT 25, 2002, before me, Richard C. Sturt Notary Public, personally appeared FAITH FREEMAN, personally known to me (or proved to me on the basis of satisfactory evidence) to be the person whose name is subscribed to the within instrument, and acknowledged to me that she executed the same in her authorized capacity, and that by her signature on the instrument the person, or the entity upon behalf of which the person acted, executed the instrument.

WITNESS my hand and official seal.




Notary Signature

IN TESTIMONY WHEREOF, I hereunto set my hand and seal this 25 day of OCT, 2002.


Scott H. Freeman

STATE OF CALIFORNIA

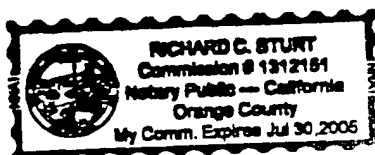
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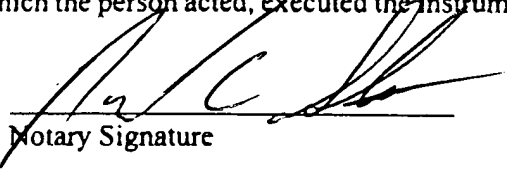
ss.

On OCT 25, 2002, before me, Richard C. Sturt Notary Public, personally appeared SCOTT H. FREEMAN, personally known to me (or proved to me on the basis of satisfactory evidence) to be the person whose name is subscribed to the within instrument, and acknowledged to me that he executed the same in his authorized capacity, and that by his signature on the instrument the person, or the entity upon behalf of which the person acted, executed the instrument.

WITNESS my hand and official seal.

[SEAL]




Notary Signature

IN TESTIMONY WHEREOF, I hereunto set my hand and seal this 21 day of Oct, 2002.


Frank H. Asbury

STATE OF CALIFORNIA)
) ss.
COUNTY OF ORANGE)

On Oct 25, 2002, before me Richard C. Sturt, Notary Public, personally appeared FRANK H. ASBURY, personally known to me (or proved to me on the basis of satisfactory evidence) to be the person whose name is subscribed to the within instrument, and acknowledged to me that he executed the same in his authorized capacity, and that by his signature on the instrument the person, or the entity upon behalf of which the person acted, executed the instrument.

WITNESS my hand and official seal.
[SEAL]


Notary Signature

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